APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,800	02/04/2000	David Angelo Ferrucci	YO999-202	7920

			EXAMINER
48150	7590	03/30/2006	HUTTON JR, WILLIAM D

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ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	09/497,800	FERRUCCI ET AL.
Office Action Summary	Examiner	Art Unit	
	Doug Hutton	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>23 January 2006</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,4-7,9-19 and 21-37</u> is/are pending in the application.

     4a) Of the above claim(s) <u>26-32,36 and 37</u> is/are withdrawn from consideration.

5) ☒ Claim(s) <u>1,4,6,7,9-17,33 and 34</u> is/are allowed.

6) ☒ Claim(s) <u>18,19,21-25 and 35</u> is/are rejected.

7) ☒ Claim(s) <u>5</u> is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>04 February 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Applicant's Response

In Applicant's Response dated 01/23/2006, Applicant amended the Specification, amended Claims 1, 5-7, 9-17, 22, 25, 33 and 34, and argued against all objections and rejections previously set forth in the Office Action dated 7 April 2005.

In light of Applicant's amendments to Claims 14 and 17, the objections to the claims previously set forth are withdrawn. In light of Applicant's amendments to Claims 1, 5-7, 9-17, 22, 25, 33 and 34, the rejections previously set forth under 35 U.S.C. 112, second paragraph for Claims 1, 4-7, 9-17, 22, 25, 33 and 34 are withdrawn.

In light of Applicant's arguments submitted in Applicant's Response dated 01/23/2006, the objection to the drawings previously set forth is withdrawn. The examiner notes that Applicant has defined the disputed claim language, a **"representation of an element in a domain model"** (Claim 18, Lines 3-4), as merely elements (e.g., numbers) in a mapping (see *Response* – Page 26, second full paragraph).

Specification

The amendment filed 01/23/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: determining

whether a "*component value*" has a "*value*," and, if so, then **not** performing a "*mapping*" (see the amended paragraph at Page 7, after Line 14, fifth sentence).

Applicant is required to cancel the new matter in the reply to this Office Action.

The disclosure remains objected to because of the following informalities:

- The phrase "The reconciliation algorithm has mapped document variable A to container variable 1 *(e.g., mapped document variable A from the document component's (e.g., reference numeral 12) to container variable 1 in the container assembly 11)*" on Page 13, Lines 12-14 should be amended to — The reconciliation algorithm has mapped document variable A to container variable 1 ~~(e.g., mapped document variable A from the document component's (e.g., reference numeral 12) to container variable 1 in the container assembly 11)~~ — so that the sentence reads more clearly. As currently worded, the text inside the parentheses of this sentence does not correspond to the preceding portion of the sentence and is difficult, if not impossible, to understand.

- the phrase "Additionally, the reconciliation algorithm has mapped component variable B to container variable 3 *((of the document component 12) in the container assembly 11 (e.g., containing document))*" on Page 13, Lines 20-22 should be amended to — Additionally, the reconciliation algorithm has mapped component variable B to container variable 3 ~~((of the document component 12) in the container assembly 11 (e.g., containing document))~~ — so that the sentence reads more clearly. As currently worded, the text inside the

parentheses of this sentence does not correspond to the preceding portion of the sentence and is difficult, if not impossible, to understand.

Appropriate correction is required.

Claim Objections

Claim 5 is objected to because of the following informalities:

- The claim recites "*when said best identity match is determined, the identified component variable is linked with the **associated container variable**"* (see Lines 1-3). This limitation is objected to because it does not accurately describe the present invention. Firstly, if a "*best identity match*" is determined, then the "*identified component variable*" is associated with an "*element in a domain model of the document*" (see Claim 1, Lines 9-11) rather than a "*container variable*," as recited in Claim 5 (see Line 3). Secondly, if a "*best identity match*" is determined, then a new "container variable" is created and the "identified component variable" is linked to the newly-created "container variable," as described in the Specification (see Page 13, Line 22 through Page 14, Line 3). Thus, Applicant should amend Claim 5 to the following: The method according to claim 1, wherein, when said best identity match is determined, <u>a new container variable is created and</u> the identified component variable is linked with the ~~associated~~ <u>newly-created</u> container variable

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 22:

The claim recites the limitation *"wherein if the component variable in the component includes a value, then **no mapping is performed** by said reconciler"* [emphasis added] (see Lines 1-3). There is **no** mention in the original Specification of determining whether a *"component value"* has a *"value,"* and, if so, then not performing a *"mapping."*

If the examiner has overlooked the portion of the original Specification that describes this feature of the present invention, then Applicant should point it out (by page number and line number) in the response to this Office Action.

Applicant may obviate this rejection by canceling the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18, 19, 21-25 and 35 remain rejected under 35 U.S.C. 102(e) as being

anticipated by Fong et al., U.S. Patent No. 6,279,015.

Claim 18:

Fong discloses *a computer-implemented method of interactively reconciling*

component variables with container variables in a document (see Figures 1-20; see

Column 1, Line 1 through Column 44, Line 19 – Fong discloses this limitation in that the

mapping interface allows a user to interactively map a transformation from one

structured format to another structured format – e.g., SGML to HTML. Through the

interactive mapping, "source" elements are mapped to "target" elements. The "source"

elements may include SGML elements and the "target" elements may include HTML

elements. Both SGML and HTML comprise elements having variables. Thus, Fong

discloses reconciling *"component variables"* with *"container variables."*), *comprising:*

- *displaying a component variable next to a representation of an element in a*

    domain model of the document (**EXAMINER'S INTERPRETATION** – The

    examiner interprets a *"representation of an element in a domain model of the*

    document" simply to be an existing mapping between a *"component variable"*

and a "*container variable.*" In **Fong** → see Figures 1-20; see Column 1, Line 1

through Column 44, Line 19 – Fong discloses this limitation in that the mapping

interface comprises a graphical user interface that displays the SGML elements

and the corresponding HTML elements.),

- *identifying an association between the component variable and said element in*

  the domain model (see Figures 1-20; see Column 1, Line 1 through Column 44,

  Line 19 – Fong discloses this limitation in that the mapping interface comprises a

  graphical user interface that displays the SGML elements and the corresponding

  HTML elements. By simply displaying the mappings, the GUI "*identifies*

  associations" between the elements.)*; and*

- *matching said element of said domain model interactively by a user* (see Figures

  1-20; see Column 1, Line 1 through Column 44, Line 19 – Fong discloses this

  limitation in that the mapping interface allows a user to interactively map a

  transformation from one structured format to another structured format.).

Claim 19:

Fong discloses *a system for reconciling component variables with container*

variables in a document relative to a domain model (see Figures 1-20; see Column 1,

Line 1 through Column 44, Line 19 – Fong discloses this limitation in that the mapping

interface allows a user to interactively map a transformation from one structured format

to another structured format – e.g., SGML to HTML. Through the interactive mapping,

"*component variables*" are "*reconciled*" with "*container variables*" in that both SGML and

HTML comprise elements having variables.), *comprising:*

- *a container including a plurality of container variables* (see Figures 1-20; see

   Column 1, Line 1 through Column 44, Line 19 – Fong discloses this limitation in

   that the mapping interface allows a user to interactively map a transformation

   from one structured format to another structured format – e.g., SGML to HTML.

   Both SGML and HTML documents include elements having "*plurality of*

   variables.");

- *a component including a plurality of component variables in said document* (see

   Figures 1-20; see Column 1, Line 1 through Column 44, Line 19 – Fong

   discloses this limitation in that the mapping interface allows a user to interactively

   map a transformation from one structured format to another structured format –

   e.g., SGML to HTML. Both SGML and HTML documents include elements

   having a "*plurality of variables.*"); *and*

- *a reconciler that maps container variables in said container, with component*

   variables in said component (see Figures 1-20; see Column 1, Line 1 through

   Column 44, Line 19 – Fong discloses this limitation in that the mapping interface

   allows a user to interactively map a transformation from one structured format to

   another structured format.),

wherein said reconciler is manually controlled by a user, to perform a mapping (see

Figures 1-20; see Column 1, Line 1 through Column 44, Line 19 – Fong discloses this

limitation in that the mapping interface allows a user to interactively map a

transformation from one structured format to another structured format.).

Claim 21:

Fong discloses *the system according to Claim 19, further comprising:*

- *a controller for automatically controlling said reconciler to perform said mapping* (see Figures 1-20; see Column 1, Line 1 through Column 44, Line 19 – Fong discloses this limitation in that the discussion of the prior art discloses automatically mapping a transformation from one structured format to another structured format.).

Claim 22:

Fong discloses *the system according to Claim 19, wherein if the component variable in the component includes a value, then no mapping is performed by said reconciler* (**EXAMINER'S INTERPRETATION** – The examiner interprets a "**wherein if the component variable in the component includes a value, then no mapping is performed by said reconciler**" simply to indicate that if a "*component variable*" already has a "*value*," then the "*container variable*" inherits that same "*value.*" In **Fong** → see Figures 1-20; see Column 1, Line 1 through Column 44, Line 19 – Fong discloses this limitation in that, during the mapping of one structured format to another structured format, attribute values may be inherited by "target" elements from "source" elements.).

Claim 23:

Fong discloses *the system according to Claim 19, wherein said component includes a plurality of alternative choices for being mapped by said reconciler* (see Figures 1-20; see Column 1, Line 1 through Column 44, Line 19 – Fong discloses this limitation in that the mapping interface allows a user to interactively map a transformation from one structured format to another structured format – e.g., SGML to HTML. Both SGML and HTML documents include elements having a *"plurality of variables."*).

Claim 24:

Fong discloses *the system according to Claim 19, wherein when said component variables in said document include a value and said reconciler is in an on-state, said reconciler reconciles said component variables in said document with said container variables in said container* (see Figures 1-20; see Column 1, Line 1 through Column 44, Line 19 – Fong discloses this limitation in that the discussion of the prior art comprises automatically mapping a transformation from one structured format to another structured format, without restricting the conditions under which the mapping is performed. Fong also discloses this limitation in that the mapping interface allows a user to interactively map a transformation from one structured format to another structured format, without restricting the conditions under which the mapping is performed.).

Claim 25:

Fong discloses *the system according to Claim 19, wherein said container variables in said container are reconciled with said component variables in said component* (see Figures 1-20; see Column 1, Line 1 through Column 44, Line 19 – Fong discloses this limitation in that the mapping interface allows a user to interactively map a transformation from one structured format to another structured format – e.g., SGML to HTML.).

Claim 35:

Claim 35 merely recites computer software for performing the method of Claim 18. The mapping interface disclosed in Fong operates via computer software. Thus, Fong discloses every limitation of Claim 35, as indicated in the above rejection for Claim 18.

Allowable Subject Matter

Claims 1, 4, 6, 7, 9-17, 33 and 34 are allowed.

The following is a statement of reasons for allowance:

Claims 1, 33 and 34:

The prior art fails to disclose or suggest the combination of limitations recited in suggested Claims 1, 33 and 34.

Claims 4, 6, 7 and 9-16:

Theses claims are dependent upon Claim 1 and thus include allowable subject

matter.

Claim 17:

The prior art fails to disclose or suggest the combination of limitations recited in

suggested Claim 17.

Claim 5 would be allowable if the claim is amended to overcome the objection to

the claim, which is set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject

matter:

Claim 5:

This claim is dependent upon Claim 1 and thus includes allowable subject

matter.

Response to Arguments

Applicant's arguments filed 01/23/2006 have been fully considered but they are

not persuasive.

The Prior Art Rejection:

Applicant notes that the examiner cited all of the figures and all of the disclosure

of the Fong reference. Thus, Applicant argues, the examiner is asserting that the

claimed invention is "clearly anticipated" by Fong. Applicant argues further that, by

citing the entire disclosure of Fong for each limitation of Claims 18, 19, 21-25 and 35,

the examiner has failed to establish a *prima facie* case of anticipation. Applicant also

states that Applicant cannot properly respond to the examiner's position, since it is

unclear what portions of Fong the examiner believes anticipate each and every element

of the claimed invention. See *Response* – Page 19.

The examiner disagrees.

Applicant is correct that the examiner did cite Figures 1-20 and Column 1, Line 1

through Column 44, Line 19 of Fong. However, the examiner also explained why the

subject matter in Fong disclosed each claim limitation. The subject matter discussed in

the examiner's explanation is found within the cited portion of Fong. Thus, Applicant

could have "properly responded" to the rejections.

Applicant argues that Fong fails to disclose "all of the features of the claimed

invention." Applicant then quotes claim language from Claims 18, 19 and 35. Applicant

then discusses features of the present invention. Applicant concludes by stating that

Fong fails to disclose "all of the features of the claimed invention." See Response –

Page 20, second paragraph through Page 23, second paragraph.

The examiner disagrees.

Firstly, the examiner notes that Applicant is misquoting Claim 35 in the argument (see *Response* – Pages 20 and 21, spanning paragraph).

Secondly, Applicant's argument fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes it from the reference. Simply stating that Fong fails to disclose "all of the features of the claimed invention" with no analysis of how the specific language of each limitation is distinguishable from the subject matter disclosed in the cited reference fails to meet the requirement of 37 CFR 1.111(b) that Applicant "specifically [point] out how the language of the claims patentably distinguishes them from the references."

Thirdly, although Applicant does not expressly argue that Fong fails to disclose a "*domain model*," the examiner will assume that is Applicant's argument.   The objection to the drawings previously set forth in the Office Action dated 10/21/2005 was withdrawn, because the Applicant has defined the disputed claim language - "**representation of an element in a domain model**" (Claim 18, Lines 3-4) - as merely elements (e.g., numbers) in a mapping (see *Response* – Page 26, second full paragraph). Now, in Applicant's arguments against the prior art rejections for Claims 18 and 35, Applicant is attempting to redefine this claim language. The examiner will interpret the claim language to correspond to Applicant's first definition.

As expressly indicated by Applicant, the "**representation of an element in a domain model**" are elements (e.g., numbers) in a mapping (see *Response* – Page 26, second full paragraph). As indicated in the above rejection for Claim 18, Fong discloses

elements in a mapping because the mapping interface comprises a graphical user interface that displays the SGML elements and the corresponding HTML elements.

Regarding Claims 19 and 21-25, the only place a "domain model" is mentioned is in the preamble of Claim 19, which states "*[a] system for reconciling component variables with container variable in a document relative to a **domain model**"* (see Lines 1-2). The "*domain model*" is not mentioned again in the claims and is not tied into any subsequent limitation. Thus, the "*domain model*" does not affect the functionality of the "system," and this language is given no patentable weight.

As indicated in the above rejections for Claims 19 and 21-25, Fong discloses every other limitation of the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Doug Hutton whose telephone number is 571-272-4137.
The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone
number for the organization where this application or proceeding is assigned is 571-
273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is (571) 272-
2100.

WDH
March 28, 2006

DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100